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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,381	06/23/2005	Isador H Lieberman	CCF-6389PCT1/US	2535
26294 7590 04/22/2009 TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVEVLAND, OH 44114				
EXAMINER				
PHILOGENE, PEDRO				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
04/22/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,381

Applicant(s)

LIEBERMAN, ISADOR H

Examiner

PEDRO PHILOGENE

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/3/09 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 8-12 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Strickland (5,507,800) in view of Jecker (2,764,814).

Strickland discloses an apparatus comprising a shaft member (10) extending between a proximal end portion and a distal end portion, the shaft member, proximal end portion and distal end portion extending substantially along a central axis, as best seen in FIGS.1,3, the proximal end portion having a first surface adapted to (capable of) receive repetitive impacts, the distal end portion including a cutting blade(16) adapted to (capable o to cut through the bone and extending in a first plane between a shield section (14) and a guide section (15) the shield section and the guide section being oppositely disposed about the central axis, the shield section and the guide section

extending axially beyond the cutting blade to recess the cutting blade in the distal end portion, the shield section including an inwardly facing shield surface, as best seen in FIG.2, which extends in a second plane that is transverse to the first plane of the cutting blade. The shield section includes an arcuate end surface for sliding underneath soft tissue present on the outer periphery surface of the bone as the shaft member is advanced, the shield surface functioning as a shield for the cutting blade to prevent cutting of the soft tissues, the shield section includes an outwardly facing ramp surface, as best seen in FIG.1, for cooperating with the arcuate end surface to lift the soft tissue off of the outer peripheral surface of the bone as the shaft member is advanced., wherein the guide section comprises a blunt tooth (17) extending generally parallel to the central axis and acting as a guide to ensure that the distal end portion of the shaft member follows the contours of the inner cortical surface of the bone as the said shaft member is advanced, wherein the guide section includes an enlarged terminal end (18) that resembles a bulb.

Applicant is reminded that anticipation under 35 USC 102 (b) or 102(e) is established when a single prior reference discloses, either expressly or under principles of inherency, each and every element of the claimed invention. *RCA Corp v. Applied Digital Data System, inc.* 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984) Furthermore, it is well settle that the law of anticipation does not require that the reference teaches what appellant is teaching or has disclosed, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claims are found in the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir.

1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference inherently discloses that element or limitation. *Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360, 21 USPQ2d. 1321 (Fed. Cir. 1991). With regard to the recitation that an element is "adapted to" or "configured to" perform a function is not a positive limitation but requires the ability to so perform. It does not constitute a limitation in any patentable sense. In addition, the manner in which a device is intended to be employed, does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1887).

It is noted that Strickland did not teach of a guide section including an enlarged substantially sphere shaped terminal end; as claimed by applicant. However, in similar art, Jecker provides the evidences of the use of a cutting instrument with a guide section including an enlarged substantially sphere shaped terminal end to prevent inadvertent injuries.

Therefore, given the teaching of Jecker, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify the device of Strickland, as taught by Jecker, to prevent inadvertent injuries.

Claims 5, 7, 13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strickland (5,507,800) in view of Jecker (2,764,814) in view of Woods (117,588).

It is noted that Strickland teaches all the limitations except for a guide section that is substantially narrower in width than the shield portion and the guide section

projects axially beyond the shield section; as claimed by applicant. However, Woods provides the evidences of the use of a guide section that is substantially narrower in width than the shield portion and the guide section projects axially beyond the shield section to widen the space or opening between the guide and the shield without increasing the width of the cutter.

Therefore, given the teaching of Woods, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Strickland, as taught by Woods to widen the space or opening between the guide and the shield without increasing the width of the cutter.

Response to Amendment

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEDRO PHILOGENE whose telephone number is (571)272-4716. The examiner can normally be reached on 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/
Primary Examiner, Art Unit 3733
April 21, 2009